

PRE-APPEAL BRIEF REQUEST FOR REVIEW

RE: Application No. **09/678,117**CUSTOMER No. **22927**

EXAMINER: FRENEL, Vanel

CONFIRM. No. **3707**

REMARKS AND ARGUMENTS

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Fifth, non-final Office Action mailed March 24, 2006 (the "Fifth Office Action"). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

A. Status of Claims

The Examiner indicates in the Fifth Office Action that only Claims 1-7, 11-12, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78- 81, 83-85 and 87-98 are pending. However, we respectfully reassert that claims 1-98 are pending, because the status of every claim ever filed in this application is as follows:

- Claims 1-98 are pending [Amendments mailed April 14, 2005; December 22, 2004; July 21, 2004; Office Action mailed October 22, 2004; and each paper indicates all of Claims 1-98 are pending]
- Claims 99-110 are cancelled [Amendment mailed July 21, 2004]
- Claims 8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86 are withdrawn from examination (but not cancelled) [Amendment mailed April 14, 2005]
- Claims 1, 13, 25, 49, 61 and 73 are generic [Office Action mailed October 22, 2004 (Paper No. 10152004)]

B. Section 103(a) Rejections

Claims 1-7, 11-15, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98 stand rejected under Section 103(a) as allegedly being unpatentable over Gamble et al., U.S. Patent No. 6,014,632 (hereinafter "Gamble") and Bro, U.S. Patent No. 5,722,418 (hereinafter "Bro"). We respectfully submit that the Examiner has not made a prima facie case of obviousness for any pending claim.

B.1. Independent Claims 1 and 46

The Examiner has not established a prima facie case of obviousness for independent method claim 1 or for independent apparatus claim 46. In particular, claims 1 and 46 recite a method and apparatus for providing a benefit to a customer that includes:

receiving an identification of a customer involved in a transaction with a third party;

determining a preventative treatment for the customer; and

offering a benefit to the customer for the transaction if the customer adopts the preventative treatment.

In paragraph 3 on page 2 of the Fifth Office Action, the Examiner acknowledges that Gamble does not disclose these features. But the Examiner goes on to state:

However, this feature is known in the art, as evidenced by Bro. In particular, Bro teaches determining a preventative treatment for the customer (See Bro, Col. 13, lines 50-62); and offering a benefit to the customer for the transaction if the customer adopts the preventative treatment (See Bro, Col. 4, lines 33-44; Col. 13, lines 50-62).

We disagree. Bro does not appear to have anything to do with the above claimed features, and does not disclose to offer a benefit to the customer for a transaction. Bro does not appear even to suggest a transaction, a benefit to a transaction, or offering such a benefit for adopting a preventative treatment. In fact, the cited portions of Bro recite the following:

In research literature on social power and influence, the degree to which patients comply with the recommendations of health care practitioners has often been seen as directly related to the physicians' use of referent, reward and coercive powers. Generally, medical recommendations are mentally internalized by patients based upon the regard in which they hold the caregiver and the continuation of some form of positive reward or reinforcer. However, in modern medical practice, physicians have shown that they generally lack the time, inclination or financial incentives for the continuing monitoring of a patient's behavior and compliance with the prescribed regime. (Col. 4, lines 33-44).

* * * * *

By mobilizing patients to accept responsibility for their own health through behavioral guidance in preventive health programs and to comply with medical prescriptions in the dispensing and taking of medicines, large savings can thereby be realized, contributing to national goals of medical cost containment. The aging of the population necessitates greater health care expenditures which in turn are aggravated by the possibility of older individuals having one or more

chronic diseases wherein non-compliance with medical regimens can become financially costly, dangerous and even life-threatening. Likewise, large savings can accrue by keeping employees motivated and focused on assigned goals. (Col. 13, lines 50-62)

Although Bro mentions “behavioral guidance” in “preventative health programs”, there is no teaching or suggestion to *offer a benefit to a customer for a transaction* with a third party, as generally recited by independent claims 1 and 46.

We also do not agree with the Examiner’s determination that it would have been obvious to combine the Gamble and Bro references. First, it is not clear how the insurance benefit amount system described in Gamble could be modified to incorporate the interactive telecommunications guidance system of Bro. Second, we submit that it would not be obvious for someone determining insurance benefit amounts (described in Gamble) to utilize an expert and the patient program to detect and manage chronic diseases (as described in Bro at col. 12, lines 47-64). But even if a motivation were known in the prior art (which we dispute) the proposed combination would not provide for all of the specific features as recited by independent claims 1 and 46, for the reasons outlined above. For example, no combination of any subject matter described in Gamble and Bro would provide for *offering a benefit to a customer for a transaction (with a third party) if that customer adopts a preventative treatment determined for that customer*.

Thus, we respectfully assert that Gamble and Bro do not support the obviousness rejections of claims 1 and 46. Moreover, we do not agree that the cited references are substantial evidence of the Examiner’s assessment of the prior art, and respectfully submit that the Examiner has not established a prima facie case of obviousness of claims 1 and 46 (or any of claims 2-7, 11-15, 17-27, 30-33, 35-37, and 39-45 which all directly or indirectly depend on claim 1). Accordingly, we request the withdrawal of the Section 103(a) rejection of these claims.

B.2. Independent claims 47 and 48

Independent claims 47 and 48 were also rejected for allegedly being unpatentable over Gamble in view of Bro. The same passage in Bro was used as support for the Examiner’s contention that Bro suggests an apparatus for offering a benefit to a customer for the transaction if the customer adopts the preventative treatment. But this argument fails for the reasons explained above, and thus we assert that claims 47 and 48 are patentably distinct over the cited art. Consequently, the Section 103(a) rejection of these claims should be withdrawn.

B.3. Independent claims 49 and 94-96

Independent claim 49 includes the feature of:

transmitting a second identification of a preventative treatment to be adopted by the customer;

The Examiner failed to cite any reference that even remotely suggests “transmitting a second identification of a preventative treatment”. In addition, the same passages of Bro were cited again for allegedly supporting the Examiner’s positions for what is taught or suggested by the prior art with regard to other features of claim 49, and these arguments fail for the same reasons set forth above. Thus, independent claim 49 is patentably distinct over the cited art. Moreover, since claims 50-55, 59-63, 65-75, 78-81, 83-85, and 87-93 all directly or indirectly depend from claim 49, these claims should also be allowable.

The Examiner rejected independent claims 94-96 in paragraph (OO) in page 14 of the Fifth Office Action for the same reasons as claim 49, because these claims “recite the same limitations”. Consequently, we submit that claims 94-96 are patentably distinct for at least the same reasons as those explained above for claim 49. Accordingly, the Section 103(a) rejection of claims 49, 50-55, 59-63, 65-75, 78-81, 83-85, 87-93, and 94-96 should be withdrawn.

B.4. Independent claim 97

Independent claim 97 pertains to a method for providing a benefit, and recites the feature of:

transmitting a second identification of the preventative treatment and a third identification of the benefit to the customer;

Once again, the Examiner cited the same passages of Bro for allegedly supporting his assertions for what is taught or suggested by the prior art, and we cannot identify any verbiage in the cited references that even suggests *transmitting a second identification of the preventative treatment and a third identification of the benefit to the customer*. The Examiner’s arguments also fail with regard to the other recited features of claim 97 for the same reasons set forth above. Consequently, independent claim 97 is patentably distinct thereover, and dependent claim 98 should be allowable for at least the same reasons.

C. Conclusion

For the reasons set forth above, we respectfully request review and reversal of all of the Section 103(a) rejections of the pending and non-withdrawn claims 1-7, 11-15, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98.

Respectfully submitted,

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Date

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